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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,340	01/16/2001	Neil E. Morrow	KMOR116839	5973

26389 7590 01/14/2003

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EXAMINER

KAVANAUGH, JOHN T

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 01/14/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/761,340

Applicant(s)

MORROW ET AL.

Examiner

Ted Kavanaugh

Art Unit

3728

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 January 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: See Continuation Sheet

  
Ted Kavanaugh  
Primary Examiner  
Art Unit: 3728

Continuation of 2. NOTE: the proposed amendment raises new issues (i.e. the applicant removed the term "unrestrained" in claims 99, 100 and 101, to overcome some indefinite language, such a change would overcome the indefinite language, however the examiner can not ignore a limitation in the claim and therefore by applicant removing such a limitation, whether indefinite or not, the examiner would have to further reconsider the prior art of record to determine if there was a better rejection to apply. The changes presented to claim 68 to overcome the indefinite language rejection are new issues. Moreover, these changes also appear to be indefinite. Claim 65 limit the medial and lateral side cable members to be attached "at only one general position thereon". However, claim 68 recite the "medial and lateral side cable members attach wherein said locations are substantially adjacent each other". If it is at one general position then how can it be at locations adjacent to each other? See figure 16 (the elected embodiment) which shows the one location and not two adjacent locations. Obviously the front portion of the boot has several location but the cable system is only attached at one location on the front of the boot. It is not clear how the proposed changes to claim 97 overcome the indefinite rejection applied. Applicant's forward lean system is not just located at a lower front location on the boot. The proposed changes to claim 102 raise new issues that would require further consideration) that would require further consideration and/or search .

Continuation of 10. Other: The declaration by Anthony O. DeRocco doesn't change the examiner's rejection. Mr. DeRocco may be familiar with the how the term is "routinely applied to boots made for skiing and snowboarding", however, by his own admission this is how the term is "routinely" applied, therefore Mr. DeRocco is implying that there is or possibly could be some variation of this term/phrase. Moreover, applicant has only worked in the design of ski boots for 7 years and all of the patents referred to in his declaration are older than 7 years, terms in the art often change over time. Mr. DeRocco doesn't appear to be an authority on "forward lean systems" prior to 7 years ago. If applicant believes his system has some additional structure than the prior art then he should put these structural changes in the claims.